Office Supreme Court, U.S.
FILED
APR 14 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 999

THE GENERAL TIRE & RUBBER COMPANY,
A BODY CORPORATE,
Petitioner,

v.

THE HONORABLE R. DORSEY WATKINS,
UNITED STATES DISTRICT JUDGE FOR
THE DISTRICT OF MARYLAND,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

NORMAN P. RAMSEY,
Suite 1750, 10 Light Street,
Baltimore, Maryland 21202,
Attorney for Petitioner.

CHARLES J. MERRIAM,
Of Counsel.

The Daily Record Co., Baltimore 3, Md.

	PAGE
Swofford v. B. & W. Inc., 34 F.R.D. 15 (S.D. Tex. 1963)	7
Thermo King v. White's Trucking Service, Inc., 292 F. 2d 668 (5th Cir. 1961)	7
Constitutional Provisions, Statutes and Rules	
Rule 38, Federal Rules of Civil Procedure	2
Rule 39, Federal Rules of Civil Procedure	3
28 U.S.C., Section 2072	2
35 U.S.C., Section 282	2, 3, 7
United States Constitution:	
Amendment V	2
Amendment VII	2

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. _____

THE GENERAL TIRE & RUBBER COMPANY
A BODY CORPORATE,

Petitioner,

v.

THE HONORABLE R. DORSEY WATKINS,
UNITED STATES DISTRICT JUDGE FOR
THE DISTRICT OF MARYLAND,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioner prays that a Writ of Certiorari issue to review the Order of the United States Court of Appeals for the Fourth Circuit, entered in the above entitled case on March 31, 1964.

CITATIONS OF OPINIONS BELOW

The opinion of the District Court, printed in Appendix to Petition for Writ of Mandamus, pp. 50-60, is unreported. The opinion of the Court of Appeals has not yet been written.

JURISDICTION

The Order of the Court of Appeals was entered on March 31, 1964 (Appendix B, p. 13, *infra*). The jurisdiction of this Court is involved under 28 U.S.C. Section 1254(1).

QUESTIONS PRESENTED

1. Whether the "Notice Pursuant to 35 U.S.C. 282" filed on January 13, 1964 is a "pleading", with the result that General Tire's demand filed on January 15, 1964 would be timely?

2. Whether a construction of 35 U.S.C. 282 and Rule 38 which would permit new factual issues triable by a jury to be raised without granting General Tire a right to demand a jury trial is a deprivation of General Tire's right to a jury trial under the Constitution of the United States?

3. Whether a construction of Rule 38(d) which would take away General Tire's right to a jury trial is contrary to Rule 38(a), 35 U.S.C. 282, the Federal Rules Enabling Act, 28 U.S.C., Section 2072, and the Constitution of the United States, Amendments V and VII:

   (a) Where there is no indication that the start of the trial would be delayed by granting a jury trial; and

   (b) Where there is no indication that a jury panel would not be available on the new trial date?

4. Whether a construction of Rule 38(d) and Rule 39(b) which would take away General Tire's right to a jury trial is contrary to Rule 38(a), 35 U.S.C. 282, the Federal Rules Enabling Act and the Constitution of the United States:

   (a) When the effect of such a construction is to prohibit a patentee to make his election as to a jury

trial after he becomes aware for the first time of the nature of the defenses he is to meet; and

(b) When the effect of such a construction is to permit an infringer, who can elect under Title 35 U.S.C. 282 to plead or give notice, and thereby gives him a greater control over a jury trial than the patentee?

5. Whether the refusal of the District Court to grant a jury trial under Rule 39(b) was an abuse of discretion:

(a) When the District Court had refused to disqualify itself upon the filing of an Affidavit of Prejudice; and

(b) When the granting of a jury trial would not cause a postponement of the trial date; and

(c) When the Plaintiffs had filed, two days prior to the Motion, a "Notice" raising many new items of alleged prior art, prior use and prior invention?

CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

The constitutional provisions, statutes and rules involved (set forth in Appendix A, *infra*) are Amendments V and VII, Constitution of the United States, Section 2672 of Title 28 U.S.C., Section 282 of Title 35 U.S.C. and Rules 38 and 39 of the Federal Rules of Civil Procedure.

STATEMENT OF THE CASE

This case involves the serious question of the denial by the Courts below of Petitioner's statutory and constitutional right to a trial by a jury.

The Respondent Judge is presiding over a suit in the District Court of Maryland, Civil Action 12,932, between

Petitioner and The Firestone Tire & Rubber Company and McCreary Tire & Rubber Company.

On January 13, 1964, Firestone and McCreary filed a document in Civil Action 12,932 entitled "Notice Pursuant to 35 U.S.C. 282" (P. App. 36-46) which sets forth various "references" and witnesses on which they proposed to rely to contest the validity of General Tire's patent. This very lengthy eleventh hour pleading raised 124 "references" or witnesses for the first time (P. App. 48-49). For example, Firestone and McCreary raised the issue of "double patenting" for the first time on January 13, 1964 in connection with their citing U.S. Patent No. 2,776,693, which allegedly shows that defense. On January 31, 1964, a new "Notice", adding 18 United States patents and 3 Canadian patents and other matters, was filed (P. App. 60-86).

On January 15, 1964, Petitioner filed a demand (P. App. 46) for a jury trial as of right under Rule 38(b) of the Federal Rules of Civil Procedure of all issues included within the January 13, 1964 pleading. Petitioner also filed a Motion (P. App. 46-47) under Rule 39(b) of the Federal Rules of Civil Procedure for a jury trial of all issues with respect to certain matters relating to the validity and infringement of the patent in suit.

On January 16, 1964, Firestone and McCreary filed a Motion to Strike (P. App. 47) the aforesaid demand and opposed the granting of the aforesaid Motion. On January 24, 1964, the Respondent rendered an oral opinion (P. App. 50-60) denying both the demand and the Motion.

On or about February 11, 1964, Petitioner filed a Petition for Writ of Mandamus in the Court of Appeals for the Fourth Circuit to review the actions of the Respondent. The Petition was denied without an oral hearing on March 31, 1964 (Appendix B, p. 13, *infra*).

On November 20, 1963, Petitioner filed an Affidavit of Prejudice with respect to the Respondent (P. App. 20-31). On November 22, 1963, the Respondent refused to withdraw from the case (P. App. 32-36).

REASONS FOR GRANTING THE WRIT

1. The Courts below have denied Petitioner's demand as of right for a jury trial on formal grounds alone. There is no controversy as to whether this is a case where a jury can be demanded. This case involves an alleged "waiver" by Petitioner and a refusal to construe a "Notice" raising numerous new issues as a "pleading." The decisions below are thus in conflict in principle with the decision in *Dairy Queen v. Wood*, 369 U.S. 469 (1962) where this Court said at pages 477-8:

> "But the constitutional right to trial by jury cannot be made to depend upon the choice of words used in the pleadings."

2. The Courts below have also denied Petitioner's Motion for a jury trial directed to the discretion of the District Court. The District Court recognized that jury trials are permissible in cases such as this, but the District Court believed that it would be inconvenient to try a case such as this before a jury because he believed it would take longer to try with a jury then without one (P. App. 59). There was no showing that a jury would not be available or that a continuance would be necessary. Under these circumstances, the District Court used a standard for the exercise of its discretion contrary to the decision of *Reid v. Covert*, 354 U.S. 1 (1957), where this Court said at page 14:

> "The concept that . . . constitutional protections . . . are inoperative when they become inconvenient or when expediency dictates otherwise is a very dangerous doctrine and if allowed to flourish would destroy the benefit of a written Constitution and undermine the basis of our government."

INDEX

Table of Contents

	PAGE
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Constitutional Provisions, Statutes And Rules Involved	3
Statement Of The Case	3
Reasons For Granting The Writ	5
Conclusion	8
Appendix A — Constitutional Provisions And Rules Involved	9
Appendix B — Order Below	13

Table of Citations

Cases

Aetna Ins. Co. v. Kennedy, 301 U.S. 389, 393 (1937)	6, 9
Bereslavsky v. Kloeb, 162 F. 2d 862 (6th Cir. 1947)	7
Columbia River Packers Ass'n v. Hinton, 54 F. Supp. 979 (D. Ore.) *reversed on other grounds*: 117 F. 2d 310, *reversed*, 315 U.S. 143, *affirmed* 131 F. 2d 88	6
Dairy Queen v. Wood, 369 U.S. 469 (1962)	5
Dimick v. Schiedl, 293 U.S. 474 (1934)	6
Reid v. Covert, 354 U.S. 1, 14 (1957)	5
Simler v. Conner, 372 U.S. 221 (1963)	6, 7
Stewart-Warner v. Lincoln Engineering, 22 F. Supp. 585 (N.D. Ill. 1938)	6

The decisions below are clearly contrary to federal policy favoring jury trials recently expressed by this Court in *Simler v. Conner*, 372 U.S. 221 (1963).

3. The *only* basis upon which the District Court denied Petitioner's demand for a jury trial was that Petitioner had "waived" its right by not filing sooner. The concept of automatic "waiver" was first injected into the Federal Court system in 1865. 5 Moore's, Federal Practice, p. 23. The Federal Rules Enabling Act and the Constitution expressly provide that a party litigant's right to a jury trial is preserved as at common law. This Court has said in *Dimick v. Schiedt*, 293 U.S. 474 (1934) that resort must be had to the appropriate rules of the common law established at the time of the adoption of the Seventh Amendment to ascertain its scope and meaning. Accordingly, the decision of the Court below is in conflict with the Seventh Amendment and *Dimick v. Scheidl*, 293 U.S. 474 (1934) because at common law Petitioner would not have "waived" a jury trial on the facts of this case. Moreover, every reasonable presumption against waiver must be indulged. *Aetna Ins. Co. v. Kennedy*, 301 U.S. 389, 393 (1937).

4. The decision below is also in conflict with *Columbia River Packers Ass'n Hinton*, 34 F. Supp. 970 (D. Ore.), *reversed on other grounds*, 117 F. 2d 310, *reversed*, 315 U.S. 143, *affirmed*, 131 F. 2d 88. That decision held that there was no waiver because defendant had no "fair notice" that treble damages were claimed until at the trial. Until January 13, 1964, Petitioner in this case had no fair notice that over 100 new references and witnesses would be relied upon by plaintiffs. Many of these *new* references and witnesses involve an attempt to show by the testimony of a series of alleged car owners that Volkswagen tires remained unchanged on two cars for seventeen years. Obviously, this type of testimony is well adapted to a trial

by jury. Another example of new issues never before raised until January 13, 1964, is the claim of "double patenting." Waiver of a jury trial cannot properly be enforced until a party litigant knows the basis for his choice. *Bereslarsky v. Kloeb*, 162 F. 2d 862 (6th Cir. 1947). Accordingly, the lower Court's decision enforcing waiver is also in conflict with *Bereslarsky v. Kloeb*, 162 F. 2d 862 (6th Cir. 1947).

5. The Federal policy favoring jury trials is of historic and continuing strength. *Simler v. Conner*, 372 U.S. 221 (1963). The willingness of the Courts below to construe every doubtful provision contrary to Petitioner places these decisions in conflict in principle with the favored policy as announced by this Court. The Courts below refused to construe the "Notice" filed pursuant to 35 U.S.C. 282 on January 13, 1964, as a "pleading" even though it determines what is to be tried and what sort of defense may be asserted. *Thermo King v. White's Trucking Service, Inc.*, 292 F. 2d 668, 675 (5th Cir. 1961). There is ample authority and there are ample reasons upon which the Courts below could have construed the "Notice" under 35 U.S.C. 282 to be a "pleading" (Petition for Writ of Mandamus, pp. 4-9). The Courts below also construed the waiver provisions of Rule 38(d) contrary to their obvious meaning and required the showing of the "raising" of new issues. This last construction of the Courts below is also contrary to *Swofford v. B. & W. Inc.*, 34 F.R.D. 15 (S.D. Tex. 1963).

6. The basic unfairness of the decisions below is clearly apparent. Petitioner was not informed as to the true nature of the defenses to be asserted until January 13, 1964. It is difficult to understand how a favored constitutional right can be waived before a party is fully apprised of the true nature of the case against him. See *Stewart-Warner*

v. Lincoln Engineering, 22 F. Supp. 585, 586, 587 (N.D. Ill. 1938). The denial of both the jury trial demand and Motion for a jury trial is particularly unreasonable because there has been no showing that any party has been prejudiced. A jury panel will be available and no continuance would be necessary. Under all these circumstances, it is clear that the Courts below have erred in denying Petitioner's request and demand for a jury trial.

CONCLUSION

For the foregoing reasons this Petition for Writ of Certiorari should be granted.

Respectfully submitted,

NORMAN P. RAMSEY,
Attorney for Petitioner.

CHARLES J. MERRIAM,
Of Counsel.

April, 1964

APPENDIX A

Constitutional Provisions, Statutes and Rules Involved

Amendment V—Capital Crimes; Double Jeopardy; Self-Incrimination; Due Process; Just Compensation for Property

No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offence to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

Amendment VII—Civil Trials

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

28 U.S.C. 2072

Rules of civil procedure for district courts

The Supreme Court shall have the power to prescribe, by general rules, the forms of process, writs, pleadings, and motions, and the practice and procedure of the district courts of the United States in civil actions.

Such rules shall not abridge, enlarge or modify any substantive right and shall preserve the right of trial by jury as at common law and as declared by the Seventh Amendment to the Constitution.

Such rules shall not take effect until they have been reported to Congress by the Chief Justice at or after the beginning of a regular session thereof but not later than the first day of May, and until the expiration of ninety days after they have been thus reported.

All laws in conflict with such rules shall be of no further force or effect after such rules have taken effect. Nothing in this title, anything therein to the contrary notwithstanding, shall in any way limit, supersede, or repeal any such rules heretofore prescribed by the Supreme Court.

35 U.S.C. 282

Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability;

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability.

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title.

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent

in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

FEDERAL RULES OF CIVIL PROCEDURE

Rule 38.

Jury Trial of Right

(a) *Right Preserved.* The right of trial by jury as declared by the Seventh Amendment to the Constitution or as given by a statute of the United States shall be preserved to the parties inviolate.

(b) *Demand.* Any party may demand a trial by jury of any issue triable of right by a jury by serving upon the other parties a demand therefor in writing at any time after the commencement of the action and not later than 10 days after the service of the last pleading directed to such issue. Such demand may be indorsed upon a pleading of the party.

(c) *Same: Specification of Issues.* In his demand a party may specify the issues which he wishes so tried; otherwise he shall be deemed to have demanded trial by jury for all the issues so triable. If he has demanded trial by jury for only some of the issues, any other party within 10 days after service of the demand or such lesser time as the court may order, may serve a demand for trial by jury of any other or all of the issues of fact in the action.

(d) *Waiver.* The failure of a party to serve a demand as required by this rule and to file it as required by Rule 5 (d) constitutes a waiver by him of trial by jury. A demand for trial by jury made as herein provided may not be withdrawn without the consent of the parties.

Rule 39.

Trial By Jury Or By The Court

(a) *By Jury.* When trial by jury has been demanded as provided in Rule 38, the action shall be designated upon the docket as a jury action. The trial of all issues so demanded shall be by jury, unless (1) the parties or their attorneys of record, by written stipulation filed with the court or by an oral stipulation made in open court and entered in the record, consent to trial by the court sitting without a jury or (2) the court upon motion or of its own initiative finds that a right of trial by jury of some or all of those issues does not exist under the Constitution or statutes of the United States.

(b) *By the Court.* Issues not demanded for trial by jury as provided in Rule 38 shall be tried by the court; but, notwithstanding the failure of a party to demand a jury in an action in which such a demand might have been made of right, the court in its discretion upon motion may order a ~~trial by a~~ jury of any or all issues.

(c) *Advisory Jury and Trial by Consent.* In all actions not triable of right by a jury the court upon motion or of its own initiative may try any issue with an advisory jury or, except in actions against the United States when a statute of the United States provides for trial without a jury, the court, with the consent of both parties, may order a trial with a jury whose verdict has the same effect as if trial by jury had been a matter of right.

APPENDIX B

United States Court of Appeals
For The Fourth Circuit

No. 9358

The General Tire & Rubber Company,
Petitioner,

The Honorable R. Dorsey Watkins,
United States District Judge
for the District of Maryland,
Respondent.

ORDER

(Filed March 31, 1964)

After due consideration of the matters arising herein, it is ORDERED:

(1) That oral argument of counsel be dispensed with;

(2) That the prayer of the Petition for a Writ of Mandamus to compel the above named Judge to grant a jury trial in Civil Action No. 12,932 pending before him in the District Court for the District of Maryland be and the same is hereby denied;

(3) That the Petition for Stay of Proceedings in said Civil Action No. 12,932 be and the same is hereby denied.

A formal written opinion will be filed herein as soon as conveniently possible.

HERBERT S. BOREMAN,
United States Circuit Judge.

ALBERT V. BRYAN,
United States Circuit Judge.

J. SPENCER BELL,
United States Circuit Judge.

Dated March 27, 1964.

LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
APR 28 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 999

THE GENERAL TIRE & RUBBER COMPANY,
A Body Corporate, *Petitioner*,

v.

THE HONORABLE R. DORSEY WATKINS, United States District Judge for the District of Maryland,
Respondent.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

EDWARD S. IRONS
1000 Connecticut Avenue
Washington, D. C.
Attorney for Amicus Curiae

Of Counsel:

WILLIAM WADE BECKETT
MARY HELEN SEARS

STANLEY M. CLARK
Of Counsel for The Firestone Tire & Rubber Company

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 999

THE GENERAL TIRE & RUBBER COMPANY,
A Body Corporate, *Petitioner*,

v.

THE HONORABLE R. DORSEY WATKINS, United States District Judge for the District of Maryland,
Respondent.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

The Firestone Tire & Rubber Company and McCreary Tire & Rubber Company respectfully move for leave to file a brief *amicus curiae* in opposition to the petition for writ of certiorari in this case.

This is the *second* mandamus proceeding arising out of Civil Action 12,932, *The Firestone Tire & Rubber Company and McCreary Tire & Rubber Company* v. *The General Tire & Rubber Company*, pending in the

United States District Court for the District of Maryland.

Trial of Civil Action 12,932 began on April 15, 1964 consonant with the denial by the Chief Justice on April 9, 1964 of two eleventh hour petitions for stay of proceedings.[1]

Petitioner filed a petition for writ of certiorari, No. 878, incident its first mandamus proceeding. In *this* proceeding, as in No. 878, amicus curiae (a) were interveners before the appellate court, and (b) are the real adversary parties in interest.

As in No. 878, the respondent judge (a) is but a nominal adverse party, (b) will file no brief in opposition to the petition, and (c) will rely upon the record and decisions below.

As in No. 878, petitioner has flatly *refused* to consent to the filing of the proposed brief *amicus*—but the respondent judge has consented.

On April 20, 1964 this Court granted the motion for leave to file a brief *amicus* in No. 878 and denied the petition.

This motion should be granted for the same reasons that the similar motion was granted in No. 878.

Petitioner has failed in its efforts to *postpone* the trial of Civil Action 12,932. Petitioner *now* seeks to

---

[1] The first stay petition filed on April 1, 1964 sought a delay of the trial of Civil Action 12,932 pending disposition of No. 878 by this Court. The second stay petition sought a delay of the trial pending disposition of the present petition No. 999.

frustrate the trial proceedings for its private ends—*not* to present a question of substance to this Court.

Respectfully submitted,

EDWARD S. IRONS
1000 Connecticut Avenue
Washington, D. C.
Attorney for Amicus Curiae

Of Counsel:

WILLIAM WADE BECKETT
MARY HELEN SEARS

STANLEY M. CLARK
Of Counsel for The Firestone Tire & Rubber Company